

REMARKS

This election is in response to the Office Action, dated July 1, 2005 ("Office Action"). Claims 1-56 are pending. No new matter has been added. Examination of the claims in view of the ensuing remarks is respectfully requested.

A supplemental Information Disclosure Statement is being submitted herewith for Examiner's consideration.

In the Office Action, Examiner required election among aspects of the claimed invention identified by two different groupings of species within the invention, under 35 U.S.C. §121. These groupings included the following:

- I. Species of the inventive benzothiopene and its prodrug when constituent R5 is O and when constituent R5 is C=O; and
- II. Species of the invention for the treatment of androgen-independent prostate cancer and the treatment of androgen-dependent prostate cancer.

Applicant hereby elects the embodiment of the instant invention including the compound and its prodrug with the **C=O** constituent of R5 for the treatment and prevention of **androgen-independent prostate cancer**, for prosecution on the merits. This election reads on claims 1-9, 11-20, 22-28, 35-43, 45-54 and 56.

The foregoing election notwithstanding, Applicant respectfully traverses the restriction requirement and submits that it is improper. Examiner cites to 35 U.S.C. § 121 as the basis for the restriction requirement; yet that section permits restriction only when (a) inventions are independent or distinct, and (b) there is a serious burden on the Examiner. MPEP § 803.

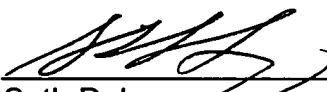
Examiner indicates that the claims are directed to two groupings of patentably distinct species of the claimed invention, however, Applicant respectfully submits that a search of the prior art with respect to the species enumerated by Examiner would not constitute an undue burden. Without a serious burden, restriction is improper.

For the foregoing reasons, Applicants respectfully request that Examiner withdraw the restriction requirement as between the species in each of groupings I and II, and respectfully request further, favorable action on the merits.

Furthermore, in the Office Action Examiner indicated that Applicant's claims 1, 12, 23, 29, 32, 35 and 46 are generic. Applicant respectfully submits that claims 1, 12, 23, 29, 32, 35 and 46 are each allowable. Therefore, Applicant submits that the non-elected embodiments of his invention, including the compound and its prodrug with the C constituent of R5 and the use of the inventive compounds for the treatment and prevention of androgen-dependent prostate cancer, are entitled to consideration as provided by 37 CFR 1.141.

All of the claims in the application are believed to be allowable. Favorable consideration and a Notice of Allowance are earnestly solicited. If for any reason Examiner finds the application other than in condition for allowance, Examiner is requested to call the undersigned attorney at the Los Angeles telephone number (213) 633-6800 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,
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Enclosures:
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Supplemental Information Disclosure Statement

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